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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,520	10/11/2001	Bettina Fath	101216-19	9360

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EXAMINER
CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
1615	

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13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/975,520	FATH ET AL.	
	Examiner	Art Unit	
	Lakshmi S Channavajjala	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Receipt of amendment B, dated 1-21-03 is acknowledged.

The following rejections have been withdrawn in response to amendment B:

Claims 1-5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,187,298 to Kurz et al (hereafter Kurz).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19810120 to Bettina et al (DE) in view of US 6,187,298 to Kurz et al.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,309,628 to Ansmann et al (hereafter Ansmann) in view of Kurz.

The following is a new rejection:

Claim Rejections - 35 USC § 112

1. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Instant claims recite the limitation "wherein the entire composition has a pH no greater than about 6", which is a new matter. Instant specification does not support the above limitation. With respect to pH, instant specification states "pH-value of the compositions used according to the invention is not critical; it can be preferably range between about 3 and about 8; in particular between about 4 and 6.5" (Page 9). Thus, while a pH between 4 and 6.5 is preferred, the specification nowhere describes the proviso as claimed. Accordingly, the limitation constitutes a new matter.

Claim Objections

2. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Instant claim once again recites green tea extract, which is recited in the parent claim.

Claim Rejections - 35 USC § 103

3. Claims 1-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,851,544 to Penska et al (hereafter Penska) in view of US 6,187,298 to Kurz.

Instant claim 1 is a hair composition on aqueous basis, comprising at least one UV-absorbing substance, green tea extract and at least one mica/titanium dioxide (TiO2) pigment, whereby at least 90% by weight thereof have a particle size between about 1 to about 250 microns, wherein the entire composition has a pH no greater than about 6. Claim 2 recites 80% to 90% of the pigment consists of mica and 10% to 20% of the pigment consists of TiO2. Claim 3 recites mica/TiO2 pigment in an amount of 0.05% to 5% by weight to the total weight of the composition. Claims 4 and 5 recite the UV absorbing compounds and their amounts from about 0.05% to 2.5%, by weight. Claims 7 and 8 recites surfactants in an amount of 0.1% to 5% by weight of the composition.

Penska teaches a cosmetic composition comprising green tea extract, octyl methoxycinnamate, titanium dioxide and triethanolamine to bring the pH of the composition to 3.8 (see example 6 in col. 10). Penska teaches the composition for hair care or skin care and

further teaches addition of surfactants such anionic, nonionic, zwitterionic surfactants. Among the surfactants, Penska mentions alkyl propanolamides such as cocomonoisopropanolamide, cocamidopropyl betaine etc (col. 5, lines 54-67). Penska teaches sunscreen agents such as TiO2 or zinc oxide, but fails to teach the claimed Mica/TiO2 particles.

Kurz teaches sunscreen compositions for protecting human hair, also for sensitized hair and also as a sunscreen, in the form of creams, lotions, aqueous and aqueous-alcoholic gels, emulsions etc (col. 6, lines 18-35). The composition of Kurz contains pigments of mica and TiO2, having a particle size of <200 microns (col. 2, lines 44-58). Kurz does not explicitly state what percentage of particles has the claimed sizes. However, examiner notes that instant specification describes Timiron, a trademark product, as the suitable mica/TiO2 pigment particles for the instant invention (page 2, lines 6-8). Kurz also teaches the same trademark product in the composition (see col. 2, lines 44-58 ad examples in col. 7-11). Accordingly, absent showing evidence to the contrary, it is examiner's position that the Timiron particles of Kurz possess the same particle size. Further, Kurz teaches the pigments in an amount of 0.5% to 20%, preferably 2-10% (col. 4, lines 36-39, col. 5, lines 19-21 and examples in col. 7-11).

For claims, 4 and 5, Kurz teaches organic UV absorbing substances (i.e., methoxycinnamte, salicylic acid derivatives, 4-aminobenzoic acid etc) as claimed in the sunscreen compositions and in the same amounts, as claimed (col. 5, lines 22-38 and examples in col. 7-11 under the trademark name Eusolex). For claim 7, examples 1-3 of Kurz recite Brij 76, which is nothing but surfactant and is a polyoxyethylene ether of higher aliphatic alcohols. Similarly, Examples 1-3 recite Miglyol, which is a fatty acid ester and reads on the claimed surfactant and is within the claimed range.

It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add mica/TiO2 pigments having a particle size of less than 200 microns (of Kurz) to the hair care compositions of Penska because Kurz teaches the mica/TiO2 particulate pigments are cosmetically well tolerated filters that filter the damaging rays in the UV and long-wave region and thus protect complete protection from solar radiation (col. 2). Further, Kurz teaches that normal as well as hair that is subjected to bleaching or dyeing, is also protected by the sunscreen pigments. Accordingly, one of an ordinary skill in the art would have expected to protect the hair from damaging solar radiation by using hair composition of Penska containing the articulate pigments of Kurz.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,851,544 to Penska in view of US 6,187,298 to Kurz as applied to claims 1-5 and 7-8 above, and further in view of US 6,309,628 to Ansmann et al.

The teachings of Penska and Kurz, discussed above, do not contain the claimed C12-C18 alkyl amidopropyl dimethyl or diethyl amine.

Ansmann teaches cosmetic hair compositions comprising a dialkyl ether, silicone compound and emulsifier such as alkyl oligoglycoside, betaines, alkyl ether sulfates etc (absent), which are more compatible with skin, less irritating and have improved conditioning and anti-static effect. Among the emulsifiers, Ansmann teaches betaines, such as carboxyalkylation products of secondary and tertiary amines (formula VI in col. 4 and formula VII in col. 5), which read on the instant betaines. In particular, C12-14 cocoalyldimethyl amine, stearyl dimethyl amineC16/18 tallow dimethyl amine, N,N-diethyl aminopropyl amine etc (col. 5, lines

1-33). Ansmann teaches using the compositions for hair applications and incorporating hair care additives such as UV filters, fragrances and anti-dandruff agents (col. 6, lines 13-21). Among the UV filters, Ansmann teaches including the claimed organic UV absorbers as well as inorganic finely dispersed metal oxides i.e., TiO2, mica, etc., having a particle size of <100 nm (col.8, lines 13-41). Thus, the teachings of Ansmann are in the same field i.e., hair care, as that of Penska and Kurz. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to substitute the emulsifiers (surfactants) of Penska with the betaines such as C12-14 cocoalyldimethyl amine, stearyl dimethyl amineC16/18 tallow dimethyl amine, N,N-diethyl aminopropyl amine etc., of Ansmann because Ansmann teaches both fatty alkyl dimethyl or monomethyl amine as suitable emulsifiers in a hair care composition. Accordingly, one of an ordinary skill in the art would have expected to achieve the same hair care properties with a mono or a dialkyl amine as an emulsifier (of Ansmann) in the composition of Penska and Kurz.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Lakshmi S Channavajjala
Patent Examiner
Art Unit 1615

April 10, 2003